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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,777	11/29/2001	Von L. Hansen	10004290-1	1721

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
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EXAMINER

SHIFERAW, ELENI A

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/995,777	Applicant(s) HANSEN, VON L.	
	Examiner Eleni A. Shiferaw	Art Unit 2136	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,4-6,8,10,11,14,16-21,23-30 and 33 is/are pending in the application.
- 4a) Of the above claim(s) 2-3, 7, 9, 12-13, 15, 22, and 31-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-6,8,10,11,14,16-21,23-30 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1,4-6,8,10,11,14,16-21,23-30 and 33 have been examined.

#### ***Response to Amendment***

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/07/2005 has been entered.

Insufficient

3. The affidavit or declaration filed on 11/07/2005 under 37 CFR 1.131 has been considered but is **ineffective to overcome the Strobel et al. Pub. No.: US 2003/0014651 A1 reference.**

#### ***Conception***

4. The evidence submitted is insufficient to establish a conception of the invention prior to ***July 12, 2001*** the effective date of the ***Strobel et al., U.S. Patent Publication 2003/0014651*** reference.

While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction

must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). (MPEP 715.07).

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice “amounts essentially to mere pleading, unsupported by proof or a showing of facts” and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit “asserts that facts exist but does not tell what they are or when they occurred.”). (MPEP 715.07).

Applicant states that “Exhibit A” of the affidavit or declaration describes the subject matter of the claimed invention.

***The declaration does not provide a clear explanation of the exhibits pointing out EXACTLY what FACTS are established and HOW they support conception of the CLAIMED invention.***

Accordingly, applicant has not met the burden of showing conception prior to the date of references.

The examiner has reviewed the supporting exhibits and does not find that they have sufficient information to support conception.

It is the Examiner’s opinion that Exhibit A does not have the degree of detail necessary to support conception even with a properly structured affidavit, because Exhibit A also fails to reach the degree of specificity found in the claims presented.

For example, at least these limitations from claim 1 are not supported by Exhibit A:

- posting a document on a server from a computer workstation as a print job;

- transmitting first security key separate from the document and that uniquely identifies the document;

Note that these comments are merely exemplary and are not comprehensive. Applicant bears the burden of providing a clear explanation of how the exhibition supports the claimed invention.

### ***Diligence***

5. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the *Strobel et al.*, (U.S. Patent Publication 2003/0014651) July 12, 2001 reference to either a constructive reduction to practice or an actual reduction to practice.

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. Ex parte Hunter, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.

In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. Ex parte Kantor, 177 USPQ 455 (Bd. App. 1958). (MPEP 715.07(a))

The critical period in which diligence must be shown begins just prior to July 12, 2001 which is the effective filing date of Strobel et al. reference and ends November 29, 2001, which is the reduction to practice/completion/filing date of the instant application.

Nothing has been shown between July 12, 2001 and last letter regarding patent application regarding the invention on November 13, 2001.

***It appears to be applicant is relying on attorney diligence (according to MPEP 2138.06) however there are no facts and evidences provided during the critical period i.e. between reference effective filing date July 12, 2001 and November 13, 2001. Most of the activities are provided before July 12, 2001(effective filing date of the reference). No diligence during the critical period between the effective filing date July 12, 2001 and the last letter on November 13, 2001.***

Applicant's showing of diligence is clearly insufficient. ***There is no activity***

*shown for almost half a year from May 25, 2001 up to November 13, 2001.*

6. Therefore, the affidavit or declaration is ineffective to overcome the Strobel et al. reference and the rejection for claims 1,4-6,8,10,11,14,16-21,23-30 and 33 have been maintained.

#### ***Claim Objection***

7. Claims 4 and 5 are objected to because of the following informalities: Claims 4 and 5 depend on the canceled claim 3. Appropriate correction is required.

8. The claim objection for claim 23 is still maintained. Applicant fails to provide corrections for the Office Action mailed on 08/26/2005.

*EP*

#### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1,4-6,8,10,11,14,19-21,23-30 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Chang et al. (Chang, Patent No.: US 6,947,995 B2).

Regarding claims 1, 10, 11, 25, 27 and 29 Chang discloses a method/printer/mobile computing device/medium comprising:

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a printing mechanism for printing a document as a print job and configured to store the print job for later execution by the printing mechanism (col. 11 lines 15-43; *output device/printer 106 printing content/text/image for received instructions from information apparatus/mobile computing device/palmtop computers/handheld devices/laptops/PDA/phones/pager/digital camera*);

a device independent program language reader (col. 7 lines 1-45);

a wireless communication module configured to received a wireless transmission securely requesting printing a document on the printer (col. 5 lines 63-col. 6 lines 11; *mobile device requesting a print service to a printer*) wherein the wireless transmission includes a security key (col. 26 lines 45-63; *entering security key from a mobile device and/or manually providing security key*) and printing instructions with both of the security key and the printing instructions provided in the wireless transmission in device independent programming language to be implemented by the device independent program language reader (fig. 9A, B, C, D, E, and F; *printing instructions/preferences from mobile device*), wherein the security key is separate from the document (col. 26 lines 45-63, fig. 9 A-F and col. 15 lines 29-36; *content is transmitted from a mobile device to printer to be printed, security key is entered manually or transmitted separately from/to the mobile device and/or the printer and the printer having access controller for security or authentication procedures and granting access by using access control list of the controller of the printer*) and the wireless communication module is configured to receive the wireless transmission of the security key at a point in time after the print job is stored via the printing mechanism (col. 4 lines 7-26).

As per claim 4, Chang teaches the method, wherein posting document comprises:

providing the printer as commercial printer wherein the server  
defines a portion of a commercial printing web site (col. 33 lines 43-52)

As per claim 5, Chang teaches the method comprises:

Specifying a location of the identified printer, apart from a plurality of other printers at  
which the document will be printed (col. 33 lines 53-67 and col. 5 lines 63-col. 6 lines 7).

As per claim 6, Chang teaches the method, wherein wirelessly transmitting a security key in  
preventing printing of the print job comprises:

transmitting the security key by at least one of the following wireless communication  
protocols: infrared; Bluetooth; and WAP (col. 13 lines 13-25).

As per claim 8, Chang teaches the method, wherein preventing printing of the print job  
comprises:

using a Java applet for wirelessly transmitting the printing instructions to print the print  
job and the security key (col. 10 lines 56-65); and

receiving and operating the Java applet, to execute the print job, with Java virtual  
machine of the identified printer (col. 7 lines 1-46).

As per claim 14, Chang teaches the method wherein posting a document comprise:



identifying via the a mobile computing device the first printer as uniquely from among a plurality of printers within a computing network (fig. 9B); and

wherein selectively delaying printing a of the print job comprises delaying printing until a presence of the mobile computing device is automatically detected via the first printer when the mobile computing device enters a wireless communication range with the first printer (col. 15 lines 29-36 and col. 26 lines 19-64; *printing is not performed unless the wireless device is detected and provide security key and user is authentic according to access control list of the printer controller security4*).

As per claim 19, Chang teaches the method and further comprising:

selectively contracting with a public printing service to print the document as the print job with the printer beings a publicly accessible printer in a public venue (col. 33 lines 36-52 and col. 26 lines 19-32);

As per claim 20, Chang teaches the method, further comprising:

specifying the server to include at least one of a private server and a server of the public printing service (col. 33 lines 36-52 and col. 26 lines 19-32).

As per claim 21 Chang teaches the printer comprising a printing system comprising:

a mobile computing device for holding the security key and printing instructions and having a wireless communication module for activating the printer to print the document as the

print job when the mobile computing device is within a select proximity of the printer (col. 15 lines 29-36 and col. 26 lines 19-64).

As per claim 23, Chang teaches the printing system wherein the server comprises a network printing manager menu comprising:

- a document identification field (col. 5 lines 27-34);
- a document upload function (col. 10 lines 29-67);
- a printer location function configured to identify a location of the printer (col. 34 lines 36-56); and
- a security key field for identifying and activating the security key to selectively control printing of the document (col. 26 lines 19-63).

As per claim 24, Chang teaches the printer and further comprising a printing system comprising:

- a server for holding the document as the print job for printing at the printer (col. 34 lines 36-56).

As per claim 26, Chang discloses the printer wherein the device independent program language reader comprises a Java virtual machine and the device independent program language reader comprises a Java virtual machine and the device independent programming language comprises Java programming language, and wherein the Java virtual machine comprises the printing instructions and the security key (col. 10 lines 56-65).

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As per claim 28, Chang teaches the mobile computing device wherein the communication module further comprises:

an authorization module configured for recognizing the printer and configured for permitting printing of the document based on at least one of a distance of the mobile computing device relative to the printer, a time factor associated with the printer, and a type of wireless transmission associated with the printer (col. 4 lines 7-26).

As per claim 30, Chang teaches the medium and further comprising:

determining whether the mobile computing device is authorized to enable execution of the print job at the identified printer based on at least one of a select proximity between a source of the wireless transmission and the identified printer, a time factor associated with the identified printer, and a type of the wireless transmission between the mobile computing device and the identified printer (col. 15 lines 29-36 and col. 26 lines 19-64).

Regarding claim 33, Chang discloses the medium wherein preventing printing of the print job comprises:

using a Java applet to send the printing instructions and the second security key from the mobile computing device to the identified printer (col. 7 lines 1-46).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al. (Chang, Patent No.: US 6,947,995 B2) in further view of Block (Pub. No.: US 2002/0010604 A1).

As per claim 16, Chang teach all the subject matter as described above. Chang fails to teach the document is an airline/passenger ticket.

However Block discloses the method wherein posting a document comprises:

providing the document as a passenger ticket service document, associated with a pre-identified consumer travel service, on then server at a consumer travel service facility (page 1 par. 0005);

wherein the printing instructions to request the pre-identified consumer travel service and printing of the passenger ticket service document (page 11 par. 0667); and

delivering the pre-identified travel service to the consumer via printing the passenger ticket service document on the printer at the consumer travel service facility (page 11 par. 0668).

Therefore it would have been obvious to one ordinary skill in the art at the time of the invention was made to print a passengers ticket, and wirelessly post a document first and send a key to print document remotely by presenting the wireless device. One of ordinary skill in the art would have been motivated to do so because it would enhance an airline security at the terminal.

As per claim 17, Chang and Block teach all the subject matter as described above. In addition, Block teaches the method wherein, providing the document comprises:

producing the passenger travel service document as an airline passenger ticket (page 13 par 0705). The rationale for combining are the same as claim 16 above.

As per claim 18, Chang and Block teach all the subject matter as described above. In addition, Block teaches the wherein producing, the passenger travel service document comprises:

providing the passenger travel service document to include printed news and entertainment information that is personal to the consumer (page 12 par. 0690). The rationale for combining are the same as claim 16 above.

### *Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

*Pub. No.: US 2003/0208691 A1 Smart et al. teaches prohibiting a printer from printing to output printed pages of the wireless devices (camera) UNLESS THE USER PERSONALLY GOES TO THE PRINTER AND ENTERS SECURITY KEY. Therefore private printing is very well known at the time of the invention was made. THE USER IS AT THE PRINTING APPARATUS AND OTHERS ARE AVOIDED FROM LOOKING AT THE USER'S PERSONAL PRIVATE JOBS/PERSONAL PRINTS (Abstract).*

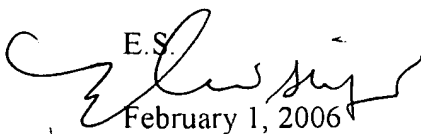
*Patent Number: 5,509,074 Choudhury et al. 1996 discloses transmitting content to be printed and secrete key separately to a printer and enabling the printer only when the secrete key is provided to the printer device (fig. 4 and abstract).*

*Patent No.: US 6,674,453 B1 Schilit et al. discloses a user selecting content to be printed/faxed from a wireless device to the nearest print service/Kinkos TM (col. 4 lines 1-44).*

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni A. Shiferaw whose telephone number is 571-272-3867. The examiner can normally be reached on Mon-Fri 8:00am-5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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February 1, 2006

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